

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

The Office Action fails to show how searching Groups I, II and III would present any undue or serious burden upon the Examiner.

For instance, a search of the polypeptides of Group I will likely also encompass a search of the polynucleotides of Group II. Moreover, a search of Group I will likely encompass a search of the Group III antibodies, especially because the Group III antibodies are elicited by the Group I polypeptides.

Accordingly, there is no undue or serious burden on the Examiner in searching and examining all of Groups I, II and III together in this one application (or at the very least, searching and examining Groups I and III together in this application).

In addition, it is noted that under the PCT Rules, Groups I and II have Unity of Invention. More in particular, Example 17 of Annex B Part 2 of the PCT Administrative Instructions (Appendix AI of the MPEP) provides:

Claim 1: Protein X

Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

Accordingly, as there is Unity of Invention between Groups I and II, there should be no undue or serious burden in examining them together in this application. Therefore, restriction between Groups I and II is improper because the criteria for restriction have not been met; for instance, as evidenced by there being Unity of Invention between Groups I and II.

And, as mentioned above the criteria for restriction between Groups I and III have not been met because there is no undue or serious burden in examining those claims together as the Group III antibodies are elicited by the Group I polypeptides and the search of Group I will encompass the Group III antibodies.

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Furthermore, the restriction requirement places an undue burden on Applicants, the public, and the PTO.

The restriction requirement calls upon Applicants to prosecute three (3) patent applications - the present application and two (2) divisionals - and pay the fees therefor (including post-issuance fees such as maintenance fees and attorney fees, *inter alia*). This is an unfair and serious burden upon Applicants.

Further, under GATT, the period of exclusivity for any patents which issue from these divisional applications is greatly reduced. This is yet a further unfair and serious burden upon Applicants.

Similarly, the public suffers an unfair burden as they will not know whether or not Applicants will file divisional applications to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining, non-elected, inventions without infringing future patents. Thus, the public suffers as a result of the restriction requirement.

The restriction requirement also calls upon the PTO to search and examine three (3) patent applications, even though there is Unity of Invention between Groups I and II, and the search of Group I will encompass the Group II and III subject matter, i.e., the restriction requirement calls upon the PTO to do duplicate work - a waste of valuable government resources.

The resources of Applicants and the PTO would be better utilized if all three Groups are searched and examined in this application: Applicants would not be forced to prosecute three (3) separate applications; and the PTO would not have to do duplicate work in searching and examining three (3) separate applications. Also, the public would be better served if all three (3) groups are searched and examined in this one application.

Clearly, in view of the foregoing, the restriction requirement should be reconsidered and withdrawn, or at the very least reformulated such that at least one of Groups II and III is also searched and examined with Group I; and, such relief is respectfully requested.

In addition, early and favorable examination on the merits is earnestly solicited.

As an aside, it is noted that Applicants filed a claim of priority and certified copies of priority documents; but, the Office Action fails to acknowledge receipt of these documents. Acknowledgement of Applicants' claim of priority and of the receipt of said certified copies of the priority documents are also respectfully requested.

Also, the Examiner is invited to telephonically contact the undersigned for a telephonic interview to advance prosecution; e.g., if prior to a first Office Action issuing the Examiner recognizes allowable subject matter and wishes to telephonically discuss such subject matter.

Respectfully submitted,

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